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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,789	07/10/2000	Satyan G. Pitroda	2683/79382	9381

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EXAMINER

TRINH, TAN H

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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09/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/612,789

Applicant(s)

PITRODA, SATYAN G.

Examiner

TAN TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-16,18 and 19 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-4, 8 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Paltenghe (U.S. Pub. No. 2002/0004783).

Regarding to claim 1, Paltenghe teaches a method of exchanging payment information in an electronic transaction (see fig. 1), comprising:

- a) a first electronic transaction device (2) transferring payment information to a second electronic transaction device (4) (See figs. 1 and 2, first electronic transaction device's item 2 or 12 (smart card or chip device or PDA) and second electronic transaction device's item 4 or 15 (server 4 or sale transaction 15) and page 4, section [0045] and page 5, section [0049-0059]).
- b) the second electronic transaction device transferring value information to the first electronic transaction device (See figs. 1, 2 and 5, second electronic transaction device's item 4 or 15 (server 4 or sale transaction 15 or merchant server) transferring value information (see fig. 5, Invoice, payment request package MIME) to first electronic transaction device's item 2, (smart

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card or chip device or PDA, or user interacts with merchant in shopping), page 6, sections [0070-0071]).

c) the second electronic transaction device transferring value information and payment information to a service consolidation center (see fig. 5, sections [0070-0075]). In this case, the virtual card can be a smart card, E-check and e-cash in the virtual wallets (see page 2, sections [0014-0018] an page 5, section [0049-0059]).

Regarding to claim 3, Paltenghe teaches the value information comprises a virtual card authorization code (see page 6, sections [0062-0065] with security and access function, account number key or and a PIN code).

Regarding to claim 4, Paltenghe teaches wherein the virtual card comprises an image of a card (see fig. 5-10, for merchants to process multiple types of electronic-payment and other transactions, and issuance of coupons on the document Imager and display virtual store value such virtual card, that is comprises an image of a card, page 2, section [0017-0018]).

Regarding to claim 8, Paltenghe teaches the payment information comprises credit payment information (see page 2, section [0017-0018] and page 7, section [0071]).

Regarding to claim 18, Paltenghe teaches wherein the virtual card comprising a digital representation of information corresponding to information stored on a physical card (see fig. 1, smart card or chip card, page 6, section [0071]). Since the physical card or virtual card to a

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merchant to consummate a particular transaction, so that the virtual card comprising a digital representation of information corresponding to information stored on a physical card.

4. Claims 12-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Arditti (U.S. Patent No. 5,991,413).

Regarding to claim 12, Arditti teaches a method of distributing virtual pre-paid cards (see fig. 1, (see col. 1, line 15-53) comprising:

a) creating virtual prepaid card (see fig. 1, col. 8, lines 11-22).

b) downloading the virtual pre-paid card to the retail electronic transaction device (see col. 1, line 45-col. 2, line 61).

(c) and transferring virtual pre-paid card from the retail electronic transaction device to MO subscriber handset (see fig. 1, col. 4, lines 53-col. 5, lines 64). In this case, after sale service, that of the purchased the transferring virtual pre-paid card from the retail electronic transaction device to mobile phone and finally that the phone connection.

Regarding to claim 13, Arditti inherently teaches the step of transferring payment information from the MO subscriber handset to the retailer electronic transaction device (see fig. 1-2, col. 1, line 44-58). In this case, the user purchase the and transferring the payment can be use the phone (10) on fig. 2 or can be using the mobile phone.

Regarding to claim 14, Arditti inherently teaches the step of creating a virtual card is performed by an electronic transaction device service center (service provider) (see fig. 1 and 2,

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col. 5, lines 33-col. 6, lines 40). In this case, the creating a virtual card is performed by an electronic transaction device service center France Telecom network.

Regarding to claim 16, Arditti teaches downloading the virtual card to a retailer electronic transaction device occurs via a MO switch (see fig. 1-2, service provide, of mobile phone (France Telephone Network, col. 5, lines 65-col. 6, lines 3). In this case, France Telephone Network can be MO switch.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe (U.S. Pub. No. 2002/0004783) in view of Resnick (U.S. Pub. No. 20010001321)

Regarding claim 5, Paltenghe teaches the value information (see page 6, section [0071]). But Paltenghe fails to teach a quantity of minutes corresponding to pre-paid telephone account.

However, Resnick teaches a quantity of minutes corresponding to pre-paid telephone account (see page 1, session [0004], lines 1-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Paltenghe and with Resnick on pre-paid

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telephone account thereto in order to provide user with the convenience for prepaid wireless service.

Regarding to claim 6, Paltenghe teaches the payment information (see page 6, section [0071]). But Paltenghe fails to teach the cash payment information.

However, Resnick teaches the cash payment information (see fig. 2, page 1, session [0003] and session [0006]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Paltenghe and by the teaching of Resnick on cash payment thereto in order to provide the convenience for user with cash payments at a multitude of merchant locations.

Regarding to claim 7, Resnick teaches the cash payment information includes an identification of a person is providing a cash payment. That is obvious to create a trace of their subscriber and created a profile for each subscriber whether they use cash or credit card (see rejection above on claim 6 and claim 8).

7. Claims 9 -11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (U.S. Patent No. 6,424,706) in view of Johnson (U. S. Patent No. 6535726).

Regarding to claim 9, Katz teaches the method of tracking retail sales of pre-paid cards to cash subscribers (see fig. 1D, col. 1, lines 25-42, and col. 4, line 39-56) comprising:

a); an entering value purchased information and subscriber information in a retailer electronic transaction device (see col. 7, lines 60-col. 8, line 47). In this case, enter the value into POS terminal, the value can be added and a mount is to be added to prepaid minute account and card information)

b) the retailer electronic transaction device transferring the value purchased information and subscriber information to a network (see col. 4, lines 39-56 and col. 8, lines 15-58).

c) the customer can adding value corresponding to the value purchased information to an account corresponding to the subscriber information (see col. 2, lines 42-50, col. 7, lines 60-col. 8, line 47). But Katz fails to teach the transferring the value to mobile phone operator or mobile phone operator.

However, Johnson teaches transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device (see fig. 1A, Mobile phone 140, transferring information from a MO subscriber handset 140 to the retailer electronic transaction device (POS) 110, col. 4, lines 24-col. 5, line 2, and col. 7, lines 3-lines 42). And MO subscriber handset can transfer information to POS (see fig. 1A, mobile 140 send information to POS 110)

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Katz with Johnson, in order to provide user using the mobile phone to pay purchased good in point of sale POS.

Regarding to claim 10, Johnson teaches the step of entering value purchased information and subscriber information in a retailer electronic transaction device (see fig. 1A, Mobile phone

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140, transferring information from a MO subscriber handset 140 to the retailer electronic transaction device (POS) 110, col. 4, lines 24-col. 5, line 2, and col. 7, lines 3-lines 42), and Johnson teaches transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device (see fig. 1A, Mobile phone 140, transferring information from a MO subscriber handset 140 to the retailer electronic transaction device (POS) 110, col. 4, lines 24-col. 5, line 2, and col. 7, lines 3-lines 42).

Regarding to claim 11, Johnson teaches manually entering the value purchased information and subscriber information into the retailer electronic transaction device (see manual customer control on POS on col. 3, lines 55-col. 4, lines 10).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arditti (U.S. Patent No. 5,991,413) in view of Pitroda (U.S. Patent No. 6769607).

Regarding to claim 15, Arditti does not mention the transferring payment information and subscriber information from the MO subscriber handset to the retailer electronic transaction device; transferring the payment information and subscriber information from the retailer electronic transaction device to the electronic transaction device service center.

However, Pitroda teaches the transferring payment information and subscriber information from the MO subscriber handset to the retailer electronic transaction device (see fig. 3, mobile phone and PDA to retailer electronic transaction device and POS); transferring the payment information and subscriber information from the retailer electronic transaction device to the

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electronic transaction device service center (see fig. 3, POS to merchant mainframe and transaction network, col. 10, lines 3-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Arditti with Pitroda, in order to provide authorized and identify on the transaction using mobile handset and POS is easier.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe (U.S. Pub. No. 2002/0004783) in view of in view of Hertzog (U.S. Pub. No. 20030069874).

Regarding to claim 19, Paltenghe fails to teach wherein the virtual card comprising logo and branding information. Such teaching is taught by Hertzog (see figs. 9A-C, with picture, company, name and logo on the virtual card).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above combination of teaching of Paltenghe with Hertzog, in order to provide user with display logo or name in virtual card.

Allowable Subject Matter

10. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 17, Arditti or Pitroda fails to teach the step of downloading batches of virtual transaction cards to the retailer electronic transaction device, as specified in dependent claim 17.

Conclusion

11. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for Technology Center 2600 only)

*Hand-delivered responses should be brought to the Customer Service Window (now located at the **Randolph Building, 401 Dulany Street, Alexandria, VA 22314**).*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (571) 272-7888. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Anderson, Matthew D., can be reached at (571) 272-4177.

The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

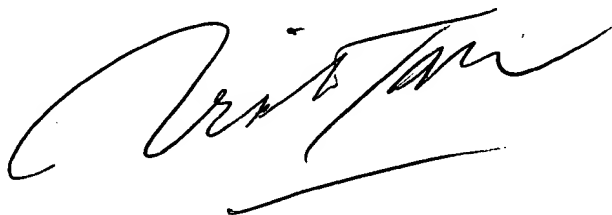
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tan H. Trinh
Division 2618
September 15, 2007

PATENT EXAMINER
TRINH, TAN

A handwritten signature in black ink, appearing to read 'Tan H. Trinh', with a long horizontal flourish extending to the right.